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Inventor: Fasnacht

REMARKS

Applicant appreciates the attention of the Examiner to the application. The Office Action of the Examiner of May 23, 2005 has been reviewed with care in the preparation of this response. The following remarks are believed to be fully responsive to this action.

Status of Claims

Claims 1-20, 27-33, and 35-46 are pending. The pending claims set forth a novel and non-obvious spinnerbait fishing lure. Reconsideration and allowance of all pending claims is respectfully requested in view of the following remarks.

Claims 1-4, 15, 27-30, 33, 35, 36, 39, 40, 42, 43 and 46 were rejected as being unpatentable under 35 U.S.C. §103(a) over Link (U.S. Patent No. 6,601,336) in view of Ogle (U.S. Patent No. 5,253,446). Claims 5-13, 37, 38 and 41 were rejected as being unpatentable under 35 U.S.C. §103(a) over Link as modified by Ogle as applied to claims 4, 36 or 40 and further in view of Smith (U.S. Patent No. 4,640,040). Claims 14, 31, 32, 44 and 45 were rejected as being unpatentable under 35 U.S.C. §103(a) over Link as modified by Ogle as applied to claims 2, 30 or 39 and further in view of Cheng (U.S. Patent No. 4,133,134). Claims 16-20 were rejected as being unpatentable under 35 U.S.C. §103(a) over Link as modified by Ogle as applied to claim 15 and further in view of Sylla et al. (U.S. Patent No. 6,226,917).

Applicant now turns to the particular points raised by the Examiner in the Office Action of May 23, 2005.

Rejection of Claim 1 under 35 U.S.C. §103(a)

Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over Link in view of Ogle. Claims 2-20, 27-33, and 35-38 are dependent to claim 1. Obviousness under 35 U.S.C. §103(a) can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). In addition, any such combination or modification of the prior art must still teach or suggest each and every one of the

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claim limitations. MPEP §2143. The references cited by the Examiner, however, do not teach or suggest all of the limitations set forth in independent claim 1.

The spinnerbait lure set forth in claim 1 includes a jig embedded within its frame. The Examiner asserts in the Office Action that this feature is disclosed only in Link and points to FIGS. 4 and 10 of that reference. In FIG. 4, the "jig" being referenced by the Examiner is a support rattle assembly 61. This assembly, however, has a flanged headpiece that is shaped to interconnect with, i.e. snap into, the recessed cavity of the end cap 24 at the end of each filament 22. (Link at col. 3, lines 34-42 and 62-65). In FIG. 10, jig 90 is shown fitted with the elastomeric collar 92 of what the Examiner asserts is a frame, the collar having a bore running its length that allows it to be slipped over the shaft of the jig. (Link at col. 4, lines 44-45; col. 7-8).

Neither embodiment of the reference's elastomeric dressing as seen in these drawings teaches or suggests that the jig in question is embedded within it. Moreover, there is nothing shown in any of the other embodiments disclosed in Link where a jig has been embedded within the elastomeric collar or filaments. Quite to the contrary, in each instance, the dressing is a modular assembly that is no more than frictionally attached to the desired jig to provide for a variety of combinations and mounting arrangements in constructing a lure. (Link at col. 1, lines 29-32). This flexibility in removing or exchanging the assembly is in fact taught as being highly desirable in certain embodiments over having it molded to the lure. (Link at col. 5, lines 54-57).

The Examiner also asserts that Link discloses a frame having upper and lower arms in a predetermined shape in a non-stressed condition. The "frame" he points to in FIG. 4, however, is an elastomeric dressing to be attached to a fishing lure having a collar 60 and two filaments 22 extending outward from the collar. This dressing or assembly is therefore a structure made from only elastomeric material. Such material is soft and easily deformable to enable the collar to easily snap on and off the lure as well as to allow spinner blade or rattle assemblies to snap on or off the filaments. (Link at col. 1, lines 6-11, 29-32).

There is no teaching or suggestion in Link that the structure of the elastomer assembly pointed out by the Examiner has a predetermined shape to which it returns whenever in a non-stressed condition. Elastomeric material permits the filaments to be deformed into any desired

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shape. (Link at col. 5, lines 54-57). Moreover, since they are no more than filaments, these elastomer appendages to the collar will be continuously returning to a flaccid configuration after force-induced flexing is withdrawn, leaving the elastomer assembly in a shape that is continuously changing over time.

The Examiner also points to a "frame" in FIG. 10. This elastomer dressing has, however, only a single appending bored arm 94. (Link at col. 4, lines 44-45). The adjacent structure to the bored arm is an elastomer collar 92. The "frame" supposedly disclosed in FIG. 10, therefore, lacks both upper and lower arms as set forth in claim 1.

The Examiner agrees that Link does not disclose a frame formed from an integral length of polymeric material. He asserts that Ogle shows such a frame, pointing specifically to column 4, lines 20-34 of that reference. This portion of the Ogle specification states that alternative embodiments of its lure may include "an elliptical ring made from polymeric materials."

The lure in Ogle is comprised, however, of both the ring 12 and two extension arms 16, 19. (Ogle at col. 3, lines 26-30). Ogle teaches a flow-through lure and the ring is an essential but distinct component from its arms since it serves to give the lure the profile and size of minnow bait and to form an aperture that enables fluid to flow through it. (Ogle at col. 4, lines 11-16, 35-40). A hook 17 and a spinner attachment 18 are secured to arms 16 and 19 respectively and not to the ring. (Ogle at col. 3, lines 41-49). There is no disclosure in Ogle of the arms being formed from plastic much less the asserted "frame", i.e., ring and extension arms, being made from a single piece of polymeric material.

Even if Ogle could arguably be said to show a frame having at least one blade and a jig secured to it and formed from an integral length of polymeric material, the Examiner has failed also to have made the necessary showing of reasons or motivation within Link and Ogle that would support the combination and modification relied upon him in rejecting claim 1 under §103(a). The Examiner makes reference in the Office Action to how "it would have been obvious to one of ordinary skill in the art to take the device of Link and add the polymeric material of Ogle, so as to allow for the device to be made of differing colors attractive to fish." This statement, however, is not the required showing of a motivation within the teachings of

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these references that one needs to have arrived at Applicant's claimed invention. A specific explanation as to how a skilled artisan can extrapolate the invention from either Link or Ogle must be set forth by the Examiner. MPEP §706.02(j).

The Examiner may not simply select from the prior art the separate components of the claimed invention through the use of the blueprint supplied by the Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). The act of identifying the various elements of the claimed invention in the prior art without there being any teaching, suggestion or motivation for their combination is not the legal test of obviousness. It is, after all, well recognized that most, if not all, inventions are no more than combinations of old elements in the prior art. Environmental Designs, Ltd. V. Union Oil Co., 713 F. 2d 693, 218 USPQ 865 (Fed. Cir. 1983); Richdel, Inc. V. Sunspool Corp., 714 F. 2d 1573, 219 USPQ 8 (Fed. Cir. 1983). "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' Sensonics, Inc. v. Aerosonic Corp., 81 F. 3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996)." In re Rouffet, 47 USPQ 2d at 1457 (Fed. Cir. 1998).

In addition, Link teaches against the modification suggested by the Examiner whereby the elastomeric material in the assembly pointed to by the Examiner is substituted with polymeric material. This change creates an assembly that always retains its original configuration absent undergoing flexing sufficient to break it. Such an assembly would lose its ability to have its collar easily snap on or off a lure or to permit various spinner blade or rattle assemblies to removably attach to one or more of its filaments. (Link at col. 1, lines 6-11, 29-32). This modification would also defeat the previous ability of the assembly to allow its arms or filaments to be formed into any desired shape. (Link at col. 5, lines 54-57). In addition, such a change would completely eliminate the ability of the filaments to be tailored to arrive at a certain preferred flexibility so that it matches, for example, that of an attached multi-stranded skirt or

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artificial bait. (Link at col. 1, lines 34-38). If a proposed combination changes the principle of operation of the prior art being modified, the teachings of the references are then not sufficient to render the claim *prima facie* obvious. MPEP §2143.01.

Nowhere in Link is there a teaching or suggestion that replacing the elastomer with certain polymers is, in any way, needed or desirable. It is simply an exercise in hindsight for the Examiner to call upon the supposed level of skill of one skilled in the art and then assert that the desired motivation comes from a need to make the assemblies different colors. If color was at all considered desirable by a skilled artisan, such color could be easily and more efficiently added to the elastomeric material itself. This can be seen with any box of colored rubber bands. The proposed modification by the Examiner is both impractical and would make the device in Link highly unsatisfactory for its obviously intended purposes.

For all of these reasons, a *prima facie* case of obviousness has not been established by the Examiner to maintain a rejection of independent claim 1. Applicant believes that this rejection should therefore be withdrawn and that this claim and each of the claims dependent to it be allowed.

Rejection of Claim 2 under 35 U.S.C. §103(a)

Claim 2 was also rejected under 35 U.S.C. §103(a) as being unpatentable over Link in view of Ogle. Claims 3-20 are dependent to claim 2. Each claim is allowable at least by virtue of its dependency from claim 1 that traverses any rejection by the Examiner for the reasons set forth above. In addition, however, claim 2 includes the limitation that the frame is dimensioned to exhibit durability and vibratory action during fishing. This feature is neither taught nor suggested by either Ogle or Link.

The Examiner points to figures in each reference in support of his rejection. These drawings are unable, by their nature, to disclose the feature set forth in claim 2. In particular, nothing is disclosed or stated in Ogle that is directed to the durability or vibratory action of the elliptical ring with use. Likewise, although some degree of oscillation may be inherent with an elastomer projection, Link fails to disclose or describe a frame structure that exhibits both vibratory action and the durability that allows the frame to resist fraying and abrasions.

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For these reasons, Applicant asks that the specific rejection of claim 2 and of claims 3-20 that depend from it be withdrawn.

Rejection of Claim 3 under 35 U.S.C. §103(a)

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Link in view of Ogle. Claims 4-13 are dependent to claim 3. Each claim is allowable at least by virtue of its dependency from claims 1 and 2 that traverse any rejection by the Examiner for the reasons set forth above. In addition, however, claim 3 includes the limitation that a fishing line/leader is attachable with respect to the frame substantially adjacent to the frame-vertex. This feature is neither taught nor suggested by either Ogle or Link.

The Examiner points to the eye 10 of the jig-head 4 in FIG. 1 of Link as showing this feature. Eye 10 is, however, not substantially adjacent to but remote from what must constitute the frame-vertex in that figure – the elastomer collar 20. This is consistent with the assertions made by the Examiner with respect to FIGS. 4 and 10.

In Ogle, the Examiner points to link 20 in FIG. 1 as also disclosing this feature. Since link 20 has a fishing line or leader attached to it at loop 20c, the Examiner is presumably referring to the point on ring 12, as shown in FIG. 1, where loop 20a of link 20 is resting as constituting the frame-vertex. This does not teach or suggest, however, a frame-vertex from which the upper and lower arms of the frame extend divergently. Such a feature is more clearly seen in FIG. 1 at point 14 of ring 12 from where arms 16 and 19 extend. This is on the opposite side of the ring from link 20 and, therefore, not at all adjacent to where the fishing line/leader attaches to the frame.

For these reasons, Applicant believes that the specific rejection of claim 3 and claims 4-13 that depend from it have been traversed and respectfully asks therefore that this rejection be withdrawn.

Rejection of Claims 27 and 29 under 35 U.S.C. §103(a)

Claims 27 and 29 were specifically rejected under 35 U.S.C. §103(a) as being unpatentable over Link in view of Ogle. Claims 28-32 are dependent to claim 27. Each claim is allowable at least by virtue of its dependency from claim 1 that traverses any rejection by the

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Examiner for reasons stated earlier. In addition, however, claims 27 and 29 include limitations that are neither taught nor suggested by either Ogle or Link.

The Examiner asserts that Link discloses a jig having a jig-head and a hook where the jig-head is embedded within the distal-end of the lower arm of the frame. He points to FIG. 4 in support of his rejection. FIG. 4 shows, however, no jig having a jig-head and hook. Moreover, for the reasons stated above with respect to the allowance of claim 1, any jig-head shown is not embedded within but is rather frictionally attached to the supposed "lower distal end."

Claim 29 adds the same limitation set forth in claim 3. For the same reasons given with respect to the allowance of claim 3, both Link and Ogle fail to teach or suggest this limitation.

Applicant asks that the specific rejection of claims 27 and 29 be withdrawn and that both claims and each of their dependent claims be allowed.

Rejection of Claims 35 and 36 under 35 U.S.C. §103(a)

Claims 35 and 36 were specifically rejected under 35 U.S.C. §103(a) as being unpatentable over Link in view of Ogle. Claims 36-38 are dependent to claim 35. Each claim is allowable at least by virtue of its dependency from claim 1 that traverses any rejection by the Examiner for reasons stated earlier. In addition, however, claims 35 and 36 include limitations that are neither taught nor suggested by either Ogle or Link.

The Examiner points to figures in each reference in support of his rejection of claim 35. These drawings (FIGS. 4 and 10 in Link and FIG. 1 in Ogle) are unable, by their nature, to disclose the limitation set forth in that claim. In particular, nothing is disclosed or stated in Ogle that is directed to the frame being dimensioned so that it exhibits flexing resilience with use during fishing. Likewise, although some degree of oscillation may be inherent with an elastomer device, Link fails to disclose or describe a frame structure that is dimensioned to specifically exhibit flexing resilience.

Claim 36 adds the limitation that the upper arm of the frame have an oblong cross-section. The Examiner points to the end caps 24 in FIG. 4 of Link in support of this rejection. The end caps fail, however, to show an oblong cross-section. This structure discloses instead a

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circular cross-section as can clearly be seen in FIG. 4. For this reason, both Link and Ogle fail to teach or suggest the restriction in this claim.

Since all of the limitations of claims 35 and 36 are not found in Link and Ogle, Applicant believes that the specific rejections of these claims should be withdrawn and each along with every claim dependent to them be allowed.

Rejection of Claim 39 under 35 U.S.C. §103(a)

Claim 39 is an independent claim rejected under 35 U.S.C. §103(a) as being unpatentable over Link in view of Ogle. Claims 40-46 are dependent to claim 39. The references cited by the Examiner fail to teach or suggest, however, all of the limitations set forth by this claim.

The Examiner asserts that Link discloses a frame having upper and lower arms in a predetermined shape in a non-stressed condition. As explained above with respect to the allowance of claim 1, however, the "frame" he points to in FIG. 4 is an elastomeric dressing to be attached to a fishing lure. This dressing or assembly is made from only elastomeric material so that it is soft and easily deformable to enable its collar to easily snap on and off the lure as well as to let spinner blade or rattle assemblies to snap on or off its filaments.

There is no teaching or suggestion in Link that the structure of the elastomer assembly pointed out by the Examiner has a predetermined shape to which it returns whenever in a non-stressed condition. Quite to the contrary, the elastomeric material chosen permits the filaments to be deformed into any desired shape. (Link at col. 5, lines 54-57). Moreover, since they are no more than filaments, these elastomer appendages to the collar will continuously return to a flaccid configuration after force-induced flexing has been withdrawn, leaving the elastomer assembly in a shape that is continuously changing over time.

The Examiner also points to a "frame" in FIG. 10 of Link. This elastomer dressing has, however, only a single appending bored arm 94. The adjacent structure to the bored arm is an elastomer collar 92. The "frame" supposedly disclosed in FIG. 10, therefore, lacks both upper and lower arms as set forth in claim 39.

The Examiner agrees that Link does not disclose an integral, polymeric frame. He asserts, however, that Ogle shows such a frame, pointing specifically to column 4, lines 20-34 of

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that reference. As explained above with regard to claim 1, this portion of the Ogle specification states only that alternative embodiments of its lure may include "an elliptical ring made from polymeric materials." Since the "frame" pointed out by the Examiner in Ogle is comprised of both the ring and two extension arms, Ogle does not teach or suggest the claimed limitation in light of the absence of any disclosure in the reference to the arms being formed from plastic much less an entire frame being made from a single piece of polymeric material.

Link and Ogle also fail to teach or suggest the limitation that a fishing line/leader is attachable with respect to the frame substantially adjacent to the frame-vertex. As explained earlier with respect to the allowance of claim 3, the Examiner points to the eye 10 of the jig-head 4 in FIG. 1 of Link as support for his rejection. This structure is, however, not substantially adjacent to but remote from what must constitute the frame-vertex in that figure – the elastomer collar 20. This identification of the frame-vertex is consistent with the assertions made by the Examiner in regard to other limitations supposedly disclosed in FIGS. 4 and 10.

In Ogle, the Examiner points to link 20 in FIG. 1 as also disclosing this feature. Since this structure is intended to have a fishing line or leader attached to it, the Examiner is presumably referring to the point on ring 12 where loop 20a of the link is seen resting as constituting the frame-vertex. This does not teach or suggest, however, a frame-vertex from which the upper and lower arms of the frame extend divergently and the only point at which the arms meet. Such a feature is seen in FIG. 1 only at point 14 from where arms 16 and 19 outwardly extend. This is on the opposite side of the ring from the link and, therefore, not at all adjacent to where the fishing line/leader attaches to the frame.

For the reasons previously set forth with regard to the allowance of claim 1, there is also a lack of an adequate showing by the Examiner in the Office Action of a reasonable motivation for the combination of the Link and Ogle references. One is therefore left with the impression that the desired modification of the prior art relied upon by the Examiner for his rejection could only have been arrived at through the hindsight that comes with the revelation of Applicant's novel lure. "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that

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create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F. 3d 1350 at 1357-1358; 47 USPQ 2d 1453 (Fed. Cir. 1998).

This lack of the necessary motivation is further supported by numerous teachings within Link against modifying its elastomer assembly in the manner suggested. Such an assembly would lose its ability to have its collar easily snap on or off a lure or to permit various spinner blade or rattle assemblies to be removably attached to one or more of its filaments. This change would also prevent the assembly from having its arms or filaments formed into different desired shapes. In addition, the proposed combination would completely eliminate the ability of the filaments to be tailored to arrive at a certain preferred flexibility.

Nowhere in Link is it taught or suggested that replacing the elastomer with certain polymers is either needed or desirable. It is simply an exercise in hindsight for the Examiner to call upon the supposed level of skill of one skilled in the art and raise as the desired motivation the supposed need to make the assemblies different colors. If color was something considered desirable by a skilled artisan, such a change could be more easily and efficiently made to the elastomeric material itself. The proposed modification by the Examiner is therefore not only highly unsatisfactory for the obviously intended purposes of the device in Link but also extremely impractical.

For each of these reasons, the case for obviousness has not been made by the Examiner to maintain the rejection of independent claim 39. Applicant believes therefore that the rejection should be withdrawn and that this claim and each of the claims dependent to it be allowed.

Rejection of Claims 40 and 42 under 35 U.S.C. §103(a)

Claims 40 and 42 were specifically rejected under 35 U.S.C. §103(a) as being unpatentable over Link in view of Ogle. Each claim is allowable at least by virtue of its dependency from claim 39 that traverses any rejection by the Examiner for reasons stated above.

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In addition, however, claims 40 and 42 include limitations that are neither taught nor suggested by either Link or Ogle.

Claim 40 adds the same limitation as is set forth in claim 36. For the same reasons given with respect to the allowance of claim 36, both Link and Ogle fail to teach or suggest this restriction. The end caps pointed to by the Examiner in FIG. 4 of Link fail to show an oblong cross-section but disclose instead a circular cross-section.

Claim 42 includes the limitations added in claim 27. As he had with respect to claim 27, the Examiner points to FIG. 4 in Link in support of this rejection. For the reasons raised above when discussing the allowance of claim 27, FIG. 4 fails to show a jig having a jig-head and hook. While the Examiner specifically asserts that a stirrup clevis 70 in that drawing is a hook, the term "hook" has a well-recognized definition to one skilled in the art of fishing lures distinguishing it over the structure shown. (See, for example, hook 8 in FIG. 1) In addition, any jig-head shown is not embedded within but is rather frictionally attached to the supposed "lower distal end."

Applicant asks that the specific rejections of claims 40 and 42 be withdrawn and that both of these claims and any dependent claims to them be allowed.

Rejection of Claims 5-7, 10 and 11 under 35 U.S.C. §103(a)

Claims 5-7, 10 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Link as modified by Ogle and further in view of Smith. Claims 6-13 are dependent to claim 5. Each claim is allowable at least by virtue of its dependency from claims 1-3 that traverse any rejection by the Examiner for reasons stated above. In addition, however, claims 5-7, 10 and 11 include limitations that are neither taught nor suggested by Link, Ogle or Smith. There is also an absence of the required showing of a justification for combining the cited references to arrive at the Applicant's claimed invention.

Claim 5 adds the limitation that the upper arm of a frame has an oblong cross-section where the frame has upper and lower arms extending divergently from a frame-vertex. The Examiner acknowledges that Link as modified by Ogle fails to disclose such a limitation, even though this is contradictory with his rejections of claims 36 and 40. Although the Examiner states that such an upper arm is taught by Smith, the structure he identifies as such has reference

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number 12. This feature is described in the specification to the reference, however, as being the rear track portion of a cyclic fishing lure. The lure in Smith therefore discloses neither upper nor lower arms extending from a frame-vertex.

Even if arguably Smith did disclose an upper arm having an oblong cross-section, there still must be more of a motivation for combining the references cited than solely the fact that a particular combination of structural features happened to have been known at the time of the invention. In the Office Action, there is no adequate showing by the Examiner of the required motivation for applying Smith to Ogle and Link.

The Examiner makes reference only to how "it would have been obvious to one of ordinary skill in the art to take the device of Link as modified by Ogle and add the upper arm of oblong cross section of Smith, so as to allow for objects to be movably connected to the frame." This assertion lacks any motivation for making the proposed combination to arrive at the claimed lure when the blade and the jig are to be secured to the frame, not movably connected to it.

In addition, Link teaches against such a modification given that to do so would create an assembly having a filament that abandons its ability to have the lure's spinner blade and rattle assemblies frictionally mounted to its end cap so that such objects may instead slide along the filament. This is therefore not the required showing but simply again an exercise in the very hindsight frowned upon by the courts. The lack of any such explanation, along with the other reasons discussed above, verifies that a *prima facie* case of obviousness has not been made by the Examiner to justify the rejection of claim 5.

Claim 6 has the additional limitation that the cross-section of the upper arm has an area that progressively decreases from the frame-vertex to the arm's distal-end. Although the Examiner states that this feature is disclosed in Smith in FIGS. 1, 2 and 6, no structure on the Smith lure is identified by the Examiner as serving as the frame-vertex. If track 12 arguably discloses an upper arm with an oblong cross-section, then the front towbar 11 needs to be included as a portion of that arm. Only in this manner can the midpoint of the towbar be considered to constitute the frame-vertex since the frame-vertex must be substantially adjacent to where a fishing line/leader attaches with respect to the frame, i.e., eyelet 16. The cross-sections

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of the sections extending in both directions from this point have, however, an area that remains constant and that do not decrease as required until the towbar connects with the track. Absent disclosure of a frame-vertex having the features set forth in the claim, the specific rejection in the Office Action of claim 6 should also be withdrawn.

Claim 7 adds the restriction that the cross-section of the upper arm has its greater dimension in the plane of the frame. This feature is also not taught or suggested by Smith. If track 12 arguably discloses the upper arm claimed by the Applicant, then the drawings in Smith only show a structure having a cross-section with its longest dimension in a direction orthogonal to the plane of the lure. Moreover, substantial modification of the track in Smith would be necessary for this structure to have an upper surface that is wider than its side edge so as to arrive at the claimed device. Smith teaches against any such modification, however, since it would be inconsistent with the required configuration of the track, a configuration needed so that each of its ends can attach to the opposite ends of the towbar.

For reasons previously set forth with regard to the allowance of claim 1, the Link and Ogle references fail to disclose a jig embedded within a frame, much less within the lower arm at the lower distal-end of that frame as directed in claim 10. This limitation is also not shown by Smith and the Examiner does not assert in the Office Action that this reference cures the deficiency in the other two.

Claim 11 adds limitations that are similar to those included in claim 27. The Examiner points to FIG. 4 in Link in support of this rejection but, as discussed with regard to the allowance of claim 27, FIG. 4 fails to show a jig having a jig-head and hook. In addition, any jig-head shown is not embedded within but is rather frictionally attached to the supposed "lower distal end." While the Examiner specifically asserts that a stirrup clevis 70 in that drawing is a hook, the term "hook" has a well-recognized definition to one skilled in the art of fishing lures distinguishing it over the structure shown. Although the Examiner also points to FIG. 1 in Link as teaching or suggesting this limitation, the elastomeric assembly asserted by the Examiner as constituting the "frame" is seen attached to a jig 2 by mounting its collar 20 around an appendage

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16 projecting from the jig-head 4. Link, in addition to Ogle and Smith, fails therefore to disclose the limitations in claim 11.

For all of these reasons, Applicant respectfully asks that the specific rejections of claims 5-7, 10 and 11 be withdrawn and that all three, in addition to each claim that depends from them, be allowed.

Rejection of Claims 37, 38 and 41 under 35 U.S.C. §103(a)

Claims 37, 38 and 41 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Link as modified by Ogle and further in view of Smith. Claims 37 and 38 are allowable at least by virtue of their dependency from claims 1, 35 and 36 that traverse any rejection by the Examiner for reasons stated above. Claim 41 is likewise allowable at least by virtue of its dependency from claims 39 and 40 that traverse any rejection by the Examiner for reasons earlier stated.

Claims 37 and 38 add the limitations also set forth in claims 6 and 7 respectively. Claim 41 combines the limitations of claims 6 and 7. As explained above with respect to the allowance of claims 6 and 7, none of the references cited by the Examiner teach or suggest an upper arm of a frame having a cross-section with an area that progressively decreases from a frame-vertex to its distal-end, the greater dimension of the cross-section being in the plane of the frame, where the frame has both upper and lower arms extending divergently from the frame-vertex.

Even if arguably each of the features in claims 37, 38 and 41 could be said to have been disclosed by one or more of the references, the Examiner also does not present a proper motivation for applying Smith to Ogle and Link. The Examiner makes reference only to how "it would have been obvious to one of ordinary skill in the art to take the device of Link as modified by Ogle and add the upper arm of Smith, so as to allow for the device to securely and adjustably hold a hook to the frame." This assertion lacks any motivation for making the proposed combination so as to arrive at the lure being claimed by Applicant. The showing required of the Examiner must make a prima facie case of obviousness and not constitute a hindsight explanation to justify the piecing together of separate components from different inventions.

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In addition, Link teaches against the suggested modification since the combination would create an assembly having a filament that abandons its ability to have the lure's spinner blade and rattle assemblies frictionally mounted to its end cap. Altering the device in Link so that it adjustably holds these assemblies (much less a hook that is never shown secured to the device) would therefore make it highly unsatisfactory for its obviously intended purposes. This change in the principle of operation of Link with the proposed combination means the teachings of the references cited are insufficient to support a rejection of these claims under §103(a). MPEP §2143.01.

For all of the reasons set forth above, the specific rejections of claims 37, 38 and 41 are asked to be withdrawn and all three, along with any claim that depends from them, should be allowed.

Rejection of Claims 14, 31, 32, 44 and 45 under 35 U.S.C. §103(a)

Claims 14, 31, 32, 44 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Link as modified by Ogle and further in view of Cheng. Claims 14, 31 and 32 are allowable at least by virtue of their dependency from claim 1 that traverses any rejection by the Examiner for reasons stated above. Claims 44 and 45 are likewise allowable at least by virtue of their dependency from claim 39 that traverses any rejection by the Examiner for reasons stated earlier. In addition, however, claims 14, 31, 32, 44 and 45 include limitations that are neither taught nor suggested by Link, Ogle or Cheng. There is also an absence of the required showing of a justification for combining these cited references so as to arrive at the Applicant's claimed invention.

Each of the claims 14, 31 and 44 add the limitation that the integral length of polymeric material that forms the frame and is selected such that the frame always retains its original configuration absent force-induced flexing sufficient to break the frame be transparent. The Examiner agrees that this limitation is not disclosed by either Link or Ogle. He points to the hollow tube 10 of the device in Cheng as teaching this restriction in the claims. This tube is, however, for receiving water soluble scented bait. This tube is rotatably mounted upon an elongated spinner shaft 11. (Cheng at col. 2, lines 57-66). A blade and a jig are shown in Chang

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secured to shaft 11. (See FIGS. 4-6). Any disclosure in Chang, therefore, as to a frame is directed to the shaft of the lure, not its hollow tube. Chang teaches that the shaft is made from a length of stiff metal wire, not transparent polymeric material. (Cheng at col. 2, lines 59-62).

The Examiner also does not present a proper motivation for applying Cheng to Ogle and Link. The Examiner makes reference only to how "it would have been obvious to one of ordinary skill in the art to take the device of Link as modified by Ogle and add the polymeric material being transparent of Cheng, so as to allow for the interior of the polymeric material to be visible." This assertion lacks any motivation for making the proposed combination so as to arrive at the lure being claimed by Applicant. Even if it did, the assertion is not taught or suggested by any of the cited references. The Examiner appears therefore to be calling upon the supposed level of skill of one skilled in the art to provide the necessary motivation for the modification of Link in view of Ogle and Cheng. This is not the showing required under the MPEP but rather an exercise in hindsight frowned upon by the courts.

Claims 32 and 45 add the limitation that the transparent polymeric frame of claims 31 and 44 respectively has color. The Examiner points to the flocked surface of a spinner blade and the tube in Cheng as showing this limitation. Flocking of the surfaces of both of these structures is to add texture not color to them. The texture is to provide a surface upon which the oil based scent materials released by the tube can adhere. (Cheng at col. 4, lines 22-37). The reference therefore fails to teach or suggest the claimed limitation.

For all of these reasons, Applicant believes that the specific rejections of claims 14, 31, 32, 44 and 45 should be withdrawn and that these claims and any claim dependent to them be allowed.

Rejection of Claims 16 - 18 under 35 U.S.C. §103(a)

Claims 16-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Link as modified by Ogle and further in view of Sylla. Claims 19 and 20 are dependent from claims 16-18. Claims 16-18 are allowable at least by virtue of their dependency from claim 1 that traverses any rejection by the Examiner for reasons stated above. In addition, however, claims 16-18 include limitations that are neither taught nor suggested by Link, Ogle or Sylla. There is also an

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absence of the required showing of a justification for combining these cited references so as to arrive at the Applicant's claimed invention.

Claim 16 adds the limitation that the integral length of polymeric material that forms the frame and is selected such that the frame always retains its original configuration absent force-induced flexing sufficient to break the frame comprises polycarbonate. The Examiner agrees that this limitation is not disclosed by either Link or Ogle. He points to end caps 14, 16 of the device in Sylla as teaching this restriction in the claim. These structures are mounted upon wire frame 12. (Sylla at col. 2, line 66 to col. 3, line 2; FIGS. 1-2). A blade and a jig are shown in Sylla secured to frame 12. (See FIG. 1). Any teaching of a frame in Sylla is directed therefore to wire frame 12 of lure 10, not its end caps. Sylla teaches that the frame is made from wire, not polycarbonate.

The Examiner also does not present a proper motivation for applying Sylla to Ogle and Link. The Examiner makes reference only to how "it would have been obvious to one of ordinary skill in the art to take the device of Link as modified by Ogle and add the polymeric material being polycarbonate of Sylla et al., so as to allow for the device to be both lightweight and durable." This assertion lacks any motivation for making the proposed combination so as to arrive at the lure being claimed by Applicant. Even if it did, the assertion is not taught or suggested by any of the cited references, especially not Sylla given that polycarbonate is suggested as a material for the end caps along with steel and lead – far from lightweight materials. The Examiner appears therefore to be simply calling upon a hypothetical level of skill of one skilled in the art to provide the necessary motivation for the modification of Link in view of Ogle and Cheng. This is not the showing required of the Examiner to make a prima facie case of obviousness but rather a hindsight explanation to justify the piecing together different inventions to create Applicant's novel and non-obvious device.

Claim 17 adds the same limitation as set forth in claim 3. For the same reasons given with respect to the allowance of claim 3, both Link and Ogle fail to teach or suggest this limitation. In addition to the disclosure of FIG. 1 of Link and FIG. 1 of Ogle that he relied upon in his rejection of claim 3, the Examiner also points to FIG. 4 in Link as showing this feature.

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FIG. 4 fails to teach, however, a frame-vertex substantially adjacent to where the fishing line/leader attaches to the frame. No line/leader is disclosed in FIG. 4 and when a similar elastomer assembly is shown attached to a lure in FIG. 1, the supposed frame-vertex, collar 60 in FIG. 4, is remote from the apparent point of attachment for the line/leader, eye 10 of jig-head 4.

Sylla also fails to teach or suggest the limitation in claim 17 that a fishing line/leader is attachable with respect to the frame substantially adjacent to the frame-vertex. A frame-vertex from which upper and lower arms of a frame extend divergently is required and this feature alone is not present. Moreover, front eyelet 20 is the only structure on wire frame 12 proximal to fishing line 25 and it is remote from and not adjacent to the line, separated by the spinner blade assembly 24.

Claim 18 adds limitations that are similar to those included in claim 27. The Examiner points to FIG. 4 in Link in support of this rejection but, as discussed with regard to the allowance of claim 27, FIG. 4 fails to show a jig having a jig-head and hook. In addition, any jig-head shown is not embedded within but is rather frictionally attached to the supposed "lower arm." Although the Examiner also points to FIG. 1 in Link as teaching or suggesting this limitation, the elastomeric assembly asserted by the Examiner as constituting the "frame" is seen attached to a jig 2 by mounting its collar 20 around an appendage 16 projecting from the jig-head 4. Embedded jig-heads are also neither taught nor suggested by either Ogle or Sylla. The references cited by the Examiner, alone or in combination, therefore fail to disclose each of the limitations in claim 18.

Applicant asks that the specific rejections of claims 16-18 be withdrawn and that each of these claims and dependent claims 19 and 20 be allowed.

Conclusion

Applicant's invention, as set forth in the pending claims, represents a highly novel and non-obvious spinnerbait lure. Applicant believes that claims 1-20, 27-33 and 35-46 include several structural features not disclosed or suggested in the prior art. Applicant submits that all rejections to these claims in the Office Action have been traversed by argument, placing these claims in condition for allowance. Applicant respectfully requests therefore that these rejections

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be reconsidered and withdrawn by the Examiner. Early favorable action is earnestly solicited. The Examiner is invited to call the undersigned if such would be helpful in resolving any issue which might remain.

Respectfully submitted,



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